

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:     BruceDonoho

Application No.: 09/317,303

Group No.: 3644

Filed: 05/24/1999

Examiner: F. Palo

For: Unitary Configured Bird Repellent Apparatus

**Mail Stop Appeal Briefs – Patents**

**Commissioner for Patents**

**P.O. Box 1450**

**Alexandria, VA 22313-1450**

**TRANSMITTAL OF APPEAL BRIEF  
(PATENT APPLICATION--37 C.F.R. § 41.37)**

1. Transmitted herewith, is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on April 25, 2007.

2. STATUS OF APPLICANT

This application is on behalf of a small entity. A statement was already filed.

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. § 41.20(b)(2), the fee for filing the Appeal Brief is:

small entity	\$250.00
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<b>Appeal Brief fee due</b>	<b>\$250.00</b>
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4. EXTENSION OF TERM

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5. TOTAL FEE DUE

The total fee due is:

Appeal brief fee	\$250.00
Extension fee (if any)	\$0.00

<b>TOTAL FEE DUE</b>	<b>\$250.00</b>
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6. FEE PAYMENT

Authorization is hereby made to charge the amount of \$250.00 to Deposit Account No. 500341.

A duplicate of this transmittal is attached.

7. FEE DEFICIENCY

If any additional extension and/or fee is required, and if any additional fee for claims is required, charge Deposit Account No. 500341.

Date:

6/25/07



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**GROUP ART UNIT 3764**

EXAMINER: F. Palo  
APPELLANT: Donoho, Bruce  
SERIAL NO. 09/317,303  
FILED: May 24, 1999  
FOR: Unitary Configured Bird Repellent Apparatus  
ART UNIT: 3644

MS Appeal Brief - Patents  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231  
Attention: Board of Patent Appeals and Interferences

**APPELLANT'S BRIEF UNDER 37 CFR § 1.192**

This brief, transmitted in triplicate, follows the appellant's Notice of Appeal filed in this matter on April 25, 2007.

The fees required under § 1.17, and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains the following items under the headings in the order here indicated:

- I. Real Party In Interest
- II. Related Appeals And Interferences
- III. Status Of Claims
- IV. Status Of Amendments
- V. Summary Of Claimed Subject Matter
- VI. Grounds of Rejection To Be Reviewed On Appeal
- VII. Argument
- VIII. Claims Appendix
- IX. Evidence Appendix
- X. Related Proceedings Appendix

## **I. Real Party In Interest**

The real parties in interest are the Applicant, Bruce Donoho.

## **II. Related Appeals And Interferences**

There are no other appeals or interferences in this matter known to appellant.

## **III. Status Of Claims**

1. Claims pending: 10-18 and 20-35;
2. Claims rejected: 10-18 and 20-35; and
4. Claims on appeal: 10-18 and 20-35.

## **IV. Status Of Amendments**

No amendments were filed after final rejection. The claims were rejected in the final Office action mailed February 26, 2007 based on amendments entered in response to non-final Office action mailed August 25, 2006. Section IX recites the claims as entered/pending and under final rejection.

## **V. Summary Of Claimed Subject Matter**

The pending claims recite a bird repellant device that has an elongated base member and integral prongs made out of a single, continuous molded piece. The configuration of prongs comprises pairs of prongs of alternating height and intermediate prongs between the alternating pairs. (see e.g., claim 10, detailed description paragraph 2, figures 1-3)

## **VI. Grounds of Rejection To Be Reviewed On Appeal**

1. Rejection of claims 10-12, 16-18, 20 and 22-34 under 35 U.S.C. § 103(a) as being unpatentable over Richardson (GB 2344269A), in view of Shaw (US 3,282,000). (Final Office action, page 4).
2. Rejection of claims 13-15 under 35 U.S.C. § 103(a) as being unpatentable over Richardson and Shaw and further in view of Burnside (US 2,777,171) (Final Office action, page 9).

3. Rejection of claims 21 under 35 U.S.C. § 103(a) as being unpatentable over Richardson and Shaw and further in view of Peles (US 2,938,243).

4. Rejection of claim 35 under 35 U.S.C. § 103(a) as being unpatentable over Richardson in view of Burnside.

## **VII. Argument**

### **BACKGROUND**

On **May 24, 1999** the appellant filed application no. 09/317303 for Unitary Configured Bird Repellent Apparatus.

On **December 3, 1999**, the Office issued an office action and rejected claims 1-8. Claims 1, 3, and 5-8 were rejected under 35 U.S.C. 102(b) as being anticipated by Shaw (US 3282000). Claim 2 was rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw. Claim 4 was rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Donoho (US 5253444). The office rejected claim 2 on the ground that it would have been obvious to make the bird repelling device by injection molding in a single unitary mold at the time of Shaw's invention. Claim 4 was rejected because Donoho discloses that it is old and well known to make the prongs with circular cross section.

On **March 2, 2000**, the appellant filed a response to the Office action dated December 3, 1999 and added new independent claim 9 and cancelled claims 1, 2 and 7 and submitted an amended drawing. The amended drawing and the added claim relates to the cutting groove feature for separating the injection molded apparatus into shorter lengths. The appellant argued that none of the reference in the office action discloses a bird repellent apparatus made of a unitary structure of injection-molded plastic and having cutting grooves.

On **April 17, 2000**, the Office issued a final office action and rejected claims 3-6, 8 and 9 as unpatentable over Shaw in view of Negre, (US 5,400,552). The office again argued that it would have been obvious to make the bird repelling device by injection molding in a single unitary mold. The office also regarded the amended drawing as introduction of new matter and disallowed the amended drawing.

On **July 17, 2000**, the appellant filed a request for reconsideration in response to the final rejection dated April 17, 2000. The appellant argued that the amended drawing did not introduce new matter, and therefore the arguments and amendments of the response dated March 2, 2000 should be reconsidered and the rejection on prior art should be viewed with the amended drawing in mind.

On **July 31, 2000**, the office issued an advisory action and denied the request to withdraw the finality of the April 17, 2000 office action.

On **Oct 17, 2000**, the appellant filed a continued prosecution application and requested three month extension of time.

On **November 3, 2000**, the office issued a final office action and maintained the rejection of claims 3-6, 8 and 9 and the exclusion of the amended drawing submitted on March 2, 2000.

On **June 7, 2001**, the office issued an abandonment notice.

On **October 27, 2004**, the appellant filed a Petition To Revive an unintentionally abandoned patent application and a Request for Continued Examination. In response to the office action dated November 3, 2000, the appellant cancelled claim 1-9 and added new claims 10-34.

On **March 16, 2005**, the office issued a decision on petition and granted the petition to revive.

On **April 26, 2005**, the office issued an office action rejecting claims 10-34. Claims 10-12, 14-18, 20, 22-27 and 30-33 were rejected as being anticipated by Richardson (GB 2344269) under 35 U.S.C. 102(a). Claims 10 and 31 were rejected because Richardson teaches a bird repellant device with a plastic molded base and a plurality of plastic prongs. Claims 11, 12, 14, 15, 20, 22, 26, 27 and 32 were rejected because Richardson depicts alternating pairs of round, sharply tipped prongs at various angles. Claims 16-18, 23 and 25 also were rejected because Richardson depicts a flanged base with flat bottom surface and ridged top surface. Finally, claims 24, 30 and 33 were rejected because Richardson teaches a base with cutting notches and a longitudinal running aperture at the bottom surface.

Furthermore, claims 13 and 28 were rejected as being unpatentable over Richardson under 35 U.S.C. 103(a). The office argued that including laterally and superiorly extending prongs in the

device would have been obvious at the time of Richardson's invention because Richardson teaches prong pairs of at least four different angles.

Claims 19, 21, 29 and 34 were rejected as being unpatentable over Richardson under 35 U.S.C. 103(a) and further in view of Shaw. The office argued that prongs with cross-shaped cross section would have been obvious at the time of the invention because without any stated advantage to be obtained, it is merely an alternate equivalent prong design performing the same function. Claim 29's superiorly extending prong extended normally from a ridge was similarly rejected as obvious because it is merely an alternate equivalent design of Richardson and Shaw.

The office suggested a rewrite of claim 10, 11, 13, 14, 18, 24 and 32 to overcome ambiguity over whether the rail and the prongs are integrally molded as a unitary apparatus.

On **July 25, 2005**, the appellant filed a response to the office action dated April 26, 2005. The appellant amended the claims according to the examiner's rewrite suggestions and cancelled claim 19. The appellant also amended independent claims 10 and 31 to require prongs with cross-shaped cross section. The appellant argued that the newly amended claims were clearly distinguishable from Shaw.

On **October 20, 2005**, the office issued a final office action, rejecting claims 10-18 and 20-34 under 35 U.S.C 102(b), as anticipated by or in the alternative, under 35 U.S.C. 103(a) as obvious over Richardson. The office rejected the amended independent claim 10, arguing that the cross-shaped cross section is merely an alternate equivalent prong configuration performing the same intended function as in Richardson, even though Richardson is silent on this subject. Amended independent claim 31 was also rejected because the office refused to give the claim's product-by-process limitation (injection molded piece) patentable weight. Dependent claims 11-18, 20-30 and 32-34 were rejected because they were not traversed upon in the response to the previous office action. The office also objected to the drawings because figure 3 and 4 were not consistent with depictions of figure 1.

On **January 19, 2006**, the applicant filed a response and a request for continued examination, and also added a new independent claim 35. The appellant argued that the criticality of the claimed subject matter is supported by the specification at paragraph bridging pages 3-4. In

particular, the specification points out that the appellant's own prior patent (US 5243444) teaches bird deterrent with "five rayed" prongs, and further points out that previously it was unknown how to manufacture such devices in a single ("unitary") plastic piece. Richardson figured out how to manufacture a unitary four-rayed deterrent, but not a five rayed version. Shaw figured out how to manufacture a five rayed version, but not in a unitary manner.

The appellant also maintained that there is no need to amend the drawings because the depictions in the figures were accurate.

On February 3, 2006, the office issued an office action rejecting claims 10-18 and 20-35. Claims 10-12, 16-18, 20 and 22-34 were rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson in view of Shaw. The office rejected claim 10 on the ground that Richardson teaches an integrally molded four-rayed plastic construction and further provides the motivation for at least a five-rayed configuration, and therefore Richardson as modified by Shaw, renders the instant invention obvious. Claims 11, 12, 16-18, 20 and 22-34 were also rejected for the same reason.

Claims 13-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson and Shaw as applied to claims 10 and 11, and further in view of Burnside (US 2777171). Claims 21 was rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson and Shaw as applied to claims 10 and further in view of Peles (US 2938243). The new independent claim 35 was rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson in view of Burnside. Claims 13-15 and 35 were rejected because the office read descriptions of prong angles in Richardson and Burnside as giving motivation for other angles such as in claim 13-15 and 35. Claim 21 was rejected because it would have been obvious to have modified the deterrent of Richardson to include the cross-shape prong cross section for the known advantages of the feature as taught by Pele.

The office withdrew its objection to the drawings from the office action dated October 20, 2005, but raised new objections to the drawings under 37 CFR 1.83(a).

On **June 2, 2006**, the appellant filed a response to the office action dated February 3, 2006. The appellant disagreed with the rejection of claims 10-18 and 20-35. The appellant argued that



Shaw only teaches rays as separated pieces from the rail because it was either impossible or impractical to injection mold a unitary deterrent with five rays; it was not until the appellant originated the idea of alternatively high and low lateral spikes that injection molding of five rayed spikes became possible. Burnside and Peles fails to contradict that fact since both of them use wire spikes rather than plastic injection molded spikes. The appellant further argued that although Richardson describes his invention as an integrally molded device having at least four different angles, it is not enabled beyond the four different angles. Richardson has no teaching, suggestion or motivation for independent claims 10, 31 and 34.

The appellant also contended that the drawing objections raised in the February 3, 2006 office action were inappropriate.

On **August 25, 2006**, the office issued a final office action, still maintaining its rejection of claims 10-18 and 20-35. Claims 10-12, 16-18, 20 and 22-34 were rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson in view of Shaw. Claims 13-15, 21 and 35 were rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson and Shaw as applied to claim 10 and further in view of Burnside and Peles. The office argued Richardson's figures depict pairs of prongs in higher position than prongs in successive pairs and thus analogous to claim 10. The office also argued Richardson's four angles provide motivation for a fifth angle, and modifying Richardson with the intermediate prong as taught by Shaw does not render Richardson incapable of maintaining construction as a continuous molded piece.

The office accepted the drawings without further objections.

On **November 30, 2006**, the appellant filed a Request for Continued Examination and a response to the office action dated August 25, 2006. Appellant argued that Richardson never contemplated prongs extending from the base other than in the pairs he describes; and he never came close to teaching or suggesting the inclusion of intermediate prongs between alternating pairs.

The appellant also disagreed with examiner's assertion that it was obvious to produce the currently claimed deterrent as a single continuous, molded piece. To that end, the appellant submitted the declaration of Josef Wisbacher of November 6, 2006. In paragraph 4 of the

declaration, Mr. Wisbacher states that as of the priority date of the current application, one of ordinary skill in the art would have thought the claimed apparatus would need to be molded in two pieces and then glued together. Although Shaw teaches a five-rayed bird deterrent, the concept of producing a single continuous mold for a deterrent with alternating side prongs and intermediate prongs was thought to be impossible. Furthermore, given that the art was aware of molded devices that can extend different pairs of prongs at different sets of angles as taught in Richardson, there was no need for a molded device with alternating side prongs and intermediate prongs. The applicant further argued that Burnside and Peles add nothing to the argument because the prongs in both patents are in pairs.

On **February 26, 2007**, the office issued a final office action and maintains its rejection of claims 10-18 and 20-35. The office insisted that the limitations of forming the deterrent as a single continuous, molded piece do not serve to patentably distinguish the claimed structure over that of the Richardson reference.

On **April 25, 2007**, the appellant filed a notice of an appeal.

## **VII. ARGUMENT**

### **A. Rejection of claims 10-12, 16-18, 20 and 22-34 under 35 U.S.C. § 103(a) as being unpatentable over Richardson (GB 2344269A) in view of Shaw (US 3,282,000)**

#### **1. The Office Failed To Establish A *Prima Facie* Showing Of Obviousness.**

35 U.S.C. 103(a) requires that the patent office support its obviousness rejections with a *prima facie* showing. (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That wasn't done in this case. Independent claims 10, 31 and 35 all recite a bird deterrent device having: (1) an elongated rail; (2) pairs of laterally extending prongs at alternating heights; and (3) a plurality of upwardly extending intermediate prongs. None of the references cited by the office teach or suggest including all three components in a single device

Instead, the Office merely offered that the claimed combination would have been a good idea because it would have made a good product. That type of reasoning just isn't sufficient for a *prima facie* showing.

In addition, there is no reason to believe that inclusion of intermediate prongs would have enhanced the deterrent function of Richardson devices. Robinson's devices already have prongs at 4 different angles, (60°, 72°, 108°, and 120°), so it is unclear why a fifth set vertical prongs would make any difference.

## **2. The Claimed Combination Is Antagonistic To Richardson's Goals.**

The Office maintains that including the intermediate pieces along with the others would have been an obvious variant (a mere design choice). That argument, however, fails because one of Richardson's goals is to make stackable devices. (See Richardson col. 2, lines 26-33).

“Advantageously the lateral staggering of the first and second pairs of prongs is such that, when viewed in the said direction, the two inner prongs (i.e. one from a first pair and one from a second pair) are angled to one another without mutually overlapping, i.e. without crossing over one another. This assists in nesting of one such bird deterrent device within another for storage and/or packing and/or transportation.” (Italics added)

One of ordinary skill in the art would have immediately appreciated that use of intermediate prongs would be entirely incompatible with stacking, and would have rejected that combination.

Richardson also had the goal of producing prongs in alternating mirror image formation. (See Richardson col. 4, lines 27-31.) Inclusion of vertical intermediate prongs would not be inconsistent with that goal, but one of ordinary skill in the art would not have considered vertical prongs where the goal was alternating mirror image prongs.

## **3. Shaw Adds Nothing To Support The Office's Rejection Of The Claims**

Shaw teaches a bird deterrent with an elongated base member and a plurality of sharp prongs. The prongs are not part of a single continuously molded piece as recited in the rejected claims. Instead the separately molded prongs are installed onto the base member via a plurality of rows of sockets.

“The elongated strip-type base support (4) has a plurality of rows of sockets (24) disposed therein. The sockets (24) as shown open onto the side walls (8) and

(10), and also onto the top wall (12). The sockets are provided so as to releasably but tightly receive a plurality of projecting shaft elements (20).” (See Shaw col. 2, lines 50-56).

There is absolutely nothing in Shaw that teaches, suggests or motivates one of ordinary skill in the art to fabricate the prongs together with the base as a single continuous piece. In fact, just the opposite is true. Shaw teaches that the objective of his invention is “the provision of such a device which is so constructed that spikes or barbed elements thereof can be easily removed from protruding positions”. (See Shaw col. 1, lines 61-63). Easy removal of the prongs is completely inconsistent with a unitary molded device.

#### **4. The Office Is Using Impermissible Hindsight To Select Elements From Different References – Against The Knowledge At The Time**

The Office is also using impermissible hindsight to combine specific elements from completely different references, to produce a combination for which there is absolutely no teaching, suggestion, or motivation. Richardson and Shaw each convey to one of ordinary skill that they have completely solved the problem at hand. One of ordinary skill in the art would not be motivated to combine the two solutions, each of which supposedly provides a complete solution to the problem. Shaw does not teach one to build a device with prongs and base molded as a single continuous piece while Richardson does not teach one to build a device with upwardly pointing intermediate prongs. Only with the benefit of hindsight would one be motivated to combine ideas from Richardson and Shaw.

Even if one were to combine those two ideas, it was completely non-obvious as of the critical date to combine the references as suggested by the Office – because it was accepted in the art that such a combination was impossible. The accepted knowledge at the time was that one could only manufacture a device such as that currently claimed by gluing together separately molded pieces. (See Wisbacher declaration). It was not until the appellant disclosed alternating prongs (high lateral (24), upward (22), low lateral (26), upward (22); see figure 2, figure 3 and paragraph 2 of detailed description) that it became apparent that such a device could be molded at all. (See Wisbacher declaration).

## **5. The Dependent Claims Are Allowable By Virtue Of Their Dependency**

Claims 11-16-18, 20, 22-30 and 34 should all be in condition for allowance by virtue of their dependence on the allowable independent claims. Furthermore, each of the claims 11-16-18, 20, 22-30 and 34 comprise additional novel elements and features that are not taught or suggested by Richardson and Shaw.

### **B. Rejection Of Claims 13-15 Under 35 U.S.C. § 103(A) As Being Unpatentable Over Richardson And Shaw And Further In View Of Burnside (US 2,777,171)**

Burnside shows a bird barrier with various cross members on a base member. The cross members and the base are all separate pieces. (See Burnside, col. 3, lines 34-47). Burnside thus fails to teach that: (1) the rail; (2) the pairs of laterally extending prongs; and (3) the intermediate prongs are all injection molded as a single continuous piece. In addition, Burnside fails to teach having laterally extending prongs extend laterally at the specifically claimed angles, (30 degrees and 70 degrees). Claims 13-15 are all allowable over the cited art.

### **C. Rejection Of Claim 21 Under 35 U.S.C. § 103(A) As Being Unpatentable Over Richardson And Shaw And Further In View Of Peles (US 2,938,243)**

This collection of references once again fails to teach the claimed combination. Peles teaches a series of straight finger portions on a body portion, where the finger portions are of different heights and point straight into the air. Peles fails to teach, suggest, or provide any motivation for first and second members of each of the plurality of pairs of laterally extending prongs include at least some portion having a cross-shaped cross-section as recited in claim 21. That claim is allowable over the cited art.

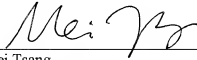
### **D. Rejection Of Claim 35 Under 35 U.S.C. § 103(A) As Being Unpatentable Over Richardson In View Of Burnside.**

Here again, the Office failed to establish a *prima facie* showing of obviousness. The Office incorrectly relies on the upwardly pointing prongs in Burnside in combination with Richardson to render the appellant's invention unpatentable. Not only does Burnside fail to teach or suggest injection molding a device in a single continuous piece, it specially calls for the base member and the spike members to be separate pieces. Claim 35 is allowable over the cited art.

## CONCLUSION

In its repeated obviousness rejections throughout the very long prosecution history, the examiner never once set forth a proper *prima facie* showing of obviousness, and completely failed to rebut the declaration. The rejections should be over-ruled.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Mei Tsang', is written over a horizontal line.

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## **VIII. CLAIMS APPENDIX**

1-9. (canceled)

10. A bird deterrent for mounting on a surface, comprising:

an elongated rail of plastic;

a plurality of pairs of prongs extending laterally from opposite sides of the rail such that successive prongs on each side of the rail alternate between a higher position and a lower position;

a plurality of upwardly extending intermediate prongs disposed among the pairs of laterally extending prongs; and

wherein the rail, the pairs of laterally extending prongs and the intermediate prongs are all injection molded as a single continuous piece.

11. The bird deterrent of claim 10, wherein each of the pairs has one prong that extends from the rail at a higher angle and one prong that extends from the rail at a lower angle.

12. The bird deterrent of claim 11, wherein each of the higher and lower angles differ from an angle defined by the intermediate prongs relative to the rail.

13. The bird deterrent of claim 10, wherein at least one of the laterally extending prongs extend laterally at about 30 degrees relative to the rail.

14. The bird deterrent of claim 10, wherein at least one of the laterally extending prongs extend laterally from the rail at about 70 degrees relative to the underlying surface.

15. The bird deterrent of claim 11, wherein the higher and lower angles of the laterally extending prongs differ by about 40 degrees.

16. The bird deterrent of claim 10, further comprising a plurality of spaced flanges extending horizontally from the rail.

17. The bird deterrent of claim 10, further comprising a plurality of spaced flanges extending from the rail, each flange continuous with one of the plurality of laterally extending prongs.

18. The bird deterrent of claim 10, wherein first and second members of each of the plurality of pairs of laterally extending prongs extend indirectly from the rail, via laterally projecting arms.

19. (canceled)

20. The bird deterrent of claim 10, wherein first and second members of each of the plurality of pairs of laterally extending prongs include at least some portion having a round cross-sectional area.

21. The bird deterrent of claim 10, wherein first and second members of each of the plurality of pairs of laterally extending prongs include at least some portion having a cross-shaped cross-section.

22. The bird deterrent of claim 10, wherein each of the laterally extending prongs terminates in a sharp tip.

23. The bird deterrent of claim 10, wherein the rail has a flat bottom surface.

24. The bird deterrent of claim 10, wherein the rail has a flat bottom surface and a longitudinal trough.

25. The bird deterrent of claim 10, further comprising a ridge along the rail.

26. The bird deterrent of claim 10, wherein each of the intermediate prongs includes a first portion having a round cross-sectional area and a second portion having a round cross-sectional area from the rail.

27. The bird deterrent of claim 10, wherein the laterally and upwardly extending prongs appear as five fanned projections from an end view of the deterrent.

28. The bird deterrent of claim 10, wherein the intermediate prongs extend normally from the rail.

29. The bird deterrent of claim 10, wherein the intermediate prongs extend normally from a ridge running along an upper surface of the rail.



30. The bird deterrent of claim 10, wherein the rail includes a plurality of spaced cutting notches.

31. A bird deterrent comprising:

a single injection molded piece having an elongated base; and

pluralities of laterally and upwardly extending prongs that collectively project from a rail in five different directions from the base, wherein the laterally extending prongs on each side of the rail alternate between lower and higher angles relative to the base.

32. The bird deterrent of claim 31, wherein the plurality of laterally extending prongs are arranged in pairs, with each pair having a first prong extending from a first side of the base at a lower angle, and a second prong extending from an opposite side of the base at a higher angle.

33. The bird deterrent of claim 31, wherein the prongs extending laterally from a first side of the base extend alternately at a lower angle and a higher angle.

34. The bird deterrent of claim 31, wherein each of the plurality of prongs further comprises a portion having a round cross-section.

35. A bird deterrent for mounting on a surface, comprising: an elongated rail and a plurality of laterally extending prongs which is injection molded as a single continuous piece, said laterally extending prongs alternating at various angles of no more than 70 degrees relative to the underlying surface.

**VIII. EVIDENCE APPENDIX**

The Applicant submitted into evidence the Nov. 6, 2006 declaration of Josef Wisbacher, and no other evidence pursuant to §§ 1.130, 1.131, or 1.132.

**IX.        RELATED PROCEEDINGS APPENDIX**

No related proceedings are known to the applicant.

## DECLARATION UNDER 37 U.S.C. 1.132

Appl. No. 09/317303  
Applicant:: Donoho, Bruce A.  
Filed: May 24, 1999  
TC/A.U.: 3644

I, the undersigned, Josef Wisbacher, hereby declare as follows:

1. I have been involved in molding plastic parts since 1973, and am presently employed as a mold maker and mold designer.
2. I recently read a copy of application of the above reference application filed by Mr. Donoho on May 24, 1999. Among other things I understand that Mr. Donoho is claiming to have developed a design for an elongated, molded plastic bird deterrent with pairs of spikes oriented so that adjacent spikes on each side alternate up and down.
3. I have no particular knowledge or experience in patent law, and I do not feel comfortable drawing legal conclusions related to such law. What I can say is that I have made molded plastic parts for literally hundreds of customers, and have an excellent understanding of what was or was not considered feasible by those in the field at different points in time.
4. As of May 24, 1999, one of ordinary skill in the art would have thought that this is/ was impossible to mold an elongated, molded plastic bird deterrent such as that claimed by Mr. Donoho in his application. In particular, one of ordinary skill in the art would have expected that such a part would have to be molded in two pieces and then glued together, and it was not appreciated at that time that merely orienting the pairs of spikes oriented so that adjacent spike on each side alternate up and down would solve that problem.
5. I consider myself to have been one of at least ordinary skill in the art as of May 24, 1999, and I would not have known how to solve that problem at that time. Nor would it have been obvious to me at that time to even try the solution invented by Mr. Donoho. If he had brought his solution to me at that time, I would have been extremely skeptical of his chances of success...not to mention the high cost of developing and producing a tool/ mold to accomplish this.

6. I hereby declare that all statements made herein of my own knowledge are true and that statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like made are punishable by fine or imprisonment, or both, under Title 18, United States Code, Section 1001, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Executed at Orange CA, this 6 th day of November, 2006

By: J. Palumbo